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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,684	12/08/2003	Edward J. Vasei	81079 7304	3287

22242 7590 07/08/2004

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

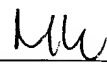
THOMSON, MICHELLE R

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/731,684	Applicant(s) VASEL ET AL.	
	Examiner Michelle (Shelley) Thomson	Art Unit 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a system for use in delivering an inhibiting substance, classified in class 102, subclass 385.
 - II. Claims 13-25, drawn to a projectile system, classified in class 102, subclass 502.
 - III. Claims 26-38, drawn to a system for delivering an inhibiting substance comprising a projectile and a means for propelling the projectile, classified in class 42, subclass 1.08.
 - IV. Claims 39-44, drawn to a method for delivering an inhibiting substance, classified in class 89, subclass 1.11.
 - V. Claims 45-47, drawn to a method of non-lethally inhibiting a target using a projectile system, classified in class 102, subclass 370.
 - VI. Claim 48, drawn to a method of non-lethally inhibiting a target by firing at a target's torso, classified in class 102, subclass 334.
 - VII. Claim 49, drawn to a method of non-lethally inhibiting a target by firing at a object near a target's face, classified in class 102, subclass 513.
 - VIII. Claims 50-51, drawn to a method of non-lethally inhibiting a target located behind a glass-like barrier, classified in class 102, subclass 506.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require

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the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require the projectile comprising a first part, and a second partially hollow part, the projectile being non-spherical, stabilizing fins secured with the second part. The subcombination has separate utility such as a training device.

3. Inventions I-VIII are otherwise unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they different modes of operation, different functions and different effects. The invention of group I operates to deliver an inhibiting substance without a projectile, it functions by having the substance contained in a hollow portion within the first and second parts and has a different effect because only a second part is non-spherical and has a plurality of stabilizing fins. The invention of group II operates to deliver an inhibiting substance with a projectile, it functions by having the substance contained in a hollow portion of the second part and it has a different effect because the projectile is non-spherical and the substance is dispersed into a cloud upon impact with a target. The invention of group III operates to deliver an inhibiting substance with a projectile, it functions by having the substance contained in a hollow portion of the second part and by having means for propelling the projectile towards the target, it has a different effect because the projectile only requires a hollow portion and the propelling means will cause the projectile to impact a target differently. The invention of group IV operates to deliver an inhibiting substance with a plurality of

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projectiles, it functions by having a substance contained in a hollow portion of the projectiles, and has a different effect because the plurality of projectiles impact the target along a vertical pattern and the plurality of projectiles will have a different result to the target than a single projectile. The invention of group V operates by delivering an inhibiting substance with a projectile, it functions by radially dispersing the substance from the projectile and it has a different effect because the radial dispersion would cover a broader area. The invention of group VI operates by firing a plurality of projectiles at a target, it functions by impacting the target in a vertical direction from a superior region to an inferior region, and has the effect of causing the target to hunch forward into the dispersed substance. The invention of group VII operates by firing a plurality of projectiles at an object in proximity to a target, it functions by the projectiles rupturing and dispersing their contents when they impact the object, and has the effect of the substance contacting the target's face region. The invention of group VIII operates by impacting a glass-like barrier with a frangible projectile, it functions by the frangible projectile fracturing the glass and then firing further projectiles comprising an inhibiting substance, and has the effect of creating a hole in the glass-like barrier.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. A telephone call was made on 7/2/04 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Thomson whose telephone number is 703.306.4176. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703.306.4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mrt

M. Thomson